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EXAMINER

BORISSOV, IGOR N

ART UNIT PAPER NUMBER

3629

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/024,621

Applicant(s)

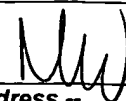
GIACCHETTI ET AL.

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 August 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

Amendment received on 8/30/2004 is acknowledged and entered. **Claims 55 and 67** have been amended. **Claims 1-69** are currently pending in the application.

Claim Objections have been withdrawn due to the applicant's amendment.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 1-69 are rejected under 35 U.S.C. 112, first paragraph**, as based on a disclosure which is not enabling. The connection between "astrological horoscope sign" and "a beauty product" is not clear. The functionality connecting the method steps of: "receiving astrological horoscope sign of a consumer" and "recommending to the consumer a beauty product" is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. The specification does not provide any explanation how one would arrive to choosing a beauty product based on receiving horoscope sign of a consumer. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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**Claims 1-55 and 67-69 are rejected under 35 U.S.C. 101** because the claimed invention is directed to non-statutory subject matter. The claimed method for providing guidance for a subject does not recite a limitation in the technological arts.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-

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statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

*The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. In re Toma at 857.*

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological-arts" test established in *Toma* because the invention in

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*State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the decision of *AT&T Corp. v. Excel Communications Inc.*, 50 USPQ2d 1447, 1449-50 (Fed. Cir. 1999), it was recognized that not everything is statutory subject matter. The court noted that a mathematical algorithm or abstract idea is directed to non-statutory subject matter unless applied in a useful way or otherwise reduced to some type of practical application. The analysis in the *AT&T Corp* decision focused on whether or not the claimed mathematical algorithm was used to produce a useful, concrete and tangible result. AT&T's claimed process employs subscribers' and call recipients' primary interexchange carrier (PIC) indicator as data, applies Boolean algebra to those data to determine the value of the PIC indicator, and applies that value through switching and recording mechanisms to create a signal useful for billing purposes. The court noted that PIC indicator represents information about the call recipient's PIC, a useful, non-abstract result that facilitates differential billing of long-distance calls made by an IXC's subscriber, and therefore, found the claimed process to comfortably fall within the scope of Section 101. *AT&T Corp.*, 50 USPQ2d 1453. Again, *AT&T Corp.* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the court in *AT&T Corp.* recognized that the claims require the use of switches and computers. In *AT&T Corp.*, the decisions of *In re Alappat*, 33 F.3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994) and *Arrhythmia Research Tech. Inc. v. Corazonix Corp.*, 958 F.2d 1053, 1060, 22 USPQ2d 1033, 1039 (Fed. Cir. 1992) were also cited. In *Alappat* it was held that more than an abstract idea was claimed because the claimed invention as a whole was directed toward forming a specific machine that produced the useful, concrete and tangible result of a smooth waveform display. In *Alappat*, the claimed invention was for a machine that achieved

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certain results and was therefore, already considered to involve the technological arts. In *Arrhythmia*, the court reasoned that the method claims qualified as statutory subject matter by noting that the steps transformed physical, electrical signals from one form into another form – a number representing a signal related to the patient's heart activity, a non-abstract output.

This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

The claims of the present application are distinguished from the claims analyzed in the decisions of *State Street*, *Alappat*, *Arrhythmia* and *AT&T*, where the claims in these cases clearly involved the use of technology as shown below.

**State Street:** The claims were in means plus function form and directed to a data processing system for managing a financial services configuration of a portfolio established as a partnership; the claims included limitations of a computer processor means for processing data, a storage means for storing data on a storage medium along with first through fifth means for processing different types of financial data. As such, the claims analyzed in *State Street* clearly involved the technological arts and, therefore, whether or not the claimed invention involved the technological arts was not an issue.

**AT&T Corp:** The claims were directed to a method for use in a telecommunications system in which interexchange calls initiated by each subscriber are automatically routed over the facilities of a particular one of a plurality of interexchange carriers associated with that subscriber comprising generating a message record for an interexchange call between an originating subscriber and a terminating subscriber, and including, in said message record, a primary interexchange carrier (PIC) indicator having a value which is a function of whether or not the interexchange carrier associated with said terminating subscriber is a predetermined one of said interexchange carriers. In considering these claims, it is clear that technology is being used to "automatically route" calls over the facilities of interexchange carriers and generating a message record for the call. Furthermore, the

courts, in analyzing these claims, clearly indicated that they recognized the claims require the use of switches and computers. See *AT&T Corp. v. Excel Communications Inc.*, 50 USPQ2d at 1450 (Fed. Cir. 1999). The court further noted that AT&T's claimed process employs subscriber's and call recipients' PICs as data, applies Boolean algebra to those data to determine the value of the PIC indicator, and applies that value through *switching and recording mechanisms* to create a signal useful for billing purposes. See *AT&T Corp. v. Excel Communications Inc.*, 50 USPQ2d at 1453 (Fed. Cir. 1999). As such, the claims analyzed in AT&T clearly involved the technological arts as recognized by the court and, therefore, whether or not the claimed invention involved the technological arts was not an issue.

**Alappat:** The claims were directed to a rasterizer for converting vector list data representing sample magnitudes of an input waveform into anti-aliased pixel illumination intensity data to be displayed on a display means comprising various means for determining distances and means for outputting illumination intensity data. Alappat's invention related generally to a means for creating a smooth waveform display in a digital oscilloscope and as indicated by the court, Alappat's invention is an improvement in an oscilloscope comparable to a TV having a clearer picture. The court reasoned that invention was statutory because the claimed invention was directed to a "machine". See *In re Alappat*, 31 USPQ2d at 1552-54 (Fed. Cir. 1994). Furthermore, in the decision of *AT&T Corp.*, the courts recognized that the claims in Alappat were for a machine that achieved certain results. See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 50 USPQ2d at 1452 (CAFC 1999). Once again, these claims clearly involve the technological arts as recognized by the court and, therefore, whether or not the claimed invention involved the technological arts was not an issue.

**Arrhythmia:** The claims were directed to a method for analyzing electrocardiograph signals to determine the presence or absence of a predetermined level of high frequency energy in the late QRS signal including the step of converting a series of QRS signals to time segments, each segment having a digital value equivalent to the analog value of said signals at said time. In considering these claims, it is clear that technology is being used to convert a series of QRS signals to time segments

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having a digital value. Once again, these claims clearly involve the technological arts since one could not convert a signal to a time segment having a digital value without the aid of a computer or some processing device and, therefore, whether or not the claimed invention involved the technological arts was not an issue.

Contrary to the claims in the above cited cases, in the present application, the claims are completely silent with regard to technology and is purely an abstract idea or process steps that are employed without the use of any technology. The claims are no more than a suggested idea of providing a beauty advice to a customer based on information about the customer. The mere fact of *receiving information* and *giving advice* does not provide a useful, concrete and tangible result.

Furthermore, the examiner submits that there are absolutely no limitations included in this claim that would suggest a computer or data processing device is being used to carry out the processes. The independently claimed steps of: *receiving profile information about the subject*; *receiving information reflecting a classification relating to birth of the subject*; and *providing beauty advice* are abstract ideas which can be performed mentally without interaction of a physical structure. The method steps of: *receiving profile information about the subject*; and *providing beauty advice* may be understood as merely obtaining an advise from a beauty consultant in a beauty salon. However, the claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (Bd. Pat. App. & Inter. 2001)). Although *Bowman* is not precedential, it has been cited for its analysis.

Moreover, in accordance with MPEP 2106 (IV)(B)(2)(b) "Statutory Process Claims", not all processes are statutory under 35 U.S.C. 101. *Schrader*, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts. See *Diamond v. Diehr*, 450 U.S. at 183-184, 209 USPQ at 6 (quoting *Gochrane v. Deener*, 94 U.S. 780, 787-788 (1877)). The claims in the present

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application do not recite any physical transformation of data whatsoever. The claims merely recite receiving information steps. Thus, there neither appears to be any physical transformation of data from one form to another, which is based upon an algorithm or a calculation by a computer or processor, nor is there any technology claimed that would be used to transform the data.

Because the independently claimed invention is directed to an abstract idea which does not provide practical applications, and does not recite a limitation in the technological arts, those claims are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

**Claims 1-55 and 67-69 are rejected under 35 U.S.C. 101** because the claimed invention is directed to non-statutory subject matter. The claimed method lacks the utility as being not credible.

“As a matter of Patent Office practice, a specification which contains a disclosure of utility which corresponds in scope to the subject matter sought to be patented must be taken as sufficient to satisfy the utility requirements of § 101 for the entire claimed subject matter unless there is a reason for one skilled in the art to question the objective truth of the statement of utility or its scope”. *In re Langer*, 503 F.2d at 1391, 183 USPQ at 297.

The examiner stipulates that it is more likely than not that one of ordinary skill in the art would doubt the credibility of beauty advice based on an astrological horoscope sign of the subject. The specification does not provide any indication of *how knowledge of the zodiac sign of the subject can lead to generating recommendation what type of cosmetic to use*. Furthermore, the specification does not provide any indication of how one of ordinary skill in the art would believe that *a course of future events may change based on use of certain beauty products*.

Because the independently claimed invention is directed to invention which is not credible, those claims are not permitted under 35 USC 101 as being related to non-

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statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1, 4-6, 9-15, 17-20, 24-27, 29-36, 43-47, 51-53, 56, 60-62 and 64-67 are rejected under 35 U.S.C. 102(e) as being anticipated by Maloney et al. (WO 01/18674 A2).**

Maloney et al. (hereinafter Maloney) teaches a method and system for providing a customized product combination to a consumer, comprising:

#### **Independent Claims.**

**Claims 1, 36, 53, 59 and 67.** Establishing a set of categories and a decision tree algorithm for classifying a consumer, the criteria including at least one of personal attribute information and lifestyle information (page 6, line 29 – page 7, line 15); advising the subject of the at least one predefined categories into which the subject is classified; and dispensing guidance including beauty advice, the guidance being a function of an lifestyle and age stage information of the consumer and the at least one predefined category into which the subject is classified (page 7, lines 30-31).

**Claim 56.** Providing a web server and a plurality of web pages relating beauty products; embedding URLs within said web pages to provide the hypertext links to other pages (page 16, line 20 – column 17, line 5).

#### **Dependent Claims.**

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**Claim 4.** See claim 1.

**Claims 5-6.** See claim 1.

**Claim 9-10.** Prompting the consumer to provide profile information, the prompting including posing to the subject a plurality of questions seeking physical attribute information about at least one of the subject's hair, skin, eyes, and facial features (page 9, lines 4-6, 17).

**Claims 11-15.** See claim 1.

**Claim 17.** See claim 1.

**Claim 18.** Said method and system wherein a beauty product is selected by the consumer (page 7, line 19). Selection of the beauty product inherently indicates selection of a brand name of said beauty product.

**Claims 19-20.** See claim 1.

**Claim 24.** Said method and system, including providing a beauty advice (page 7, lines 30-31). Information as to *how to apply at least one beauty product* is not given patentable weight. ) *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 404, 404 (Fed. Cir. 1983). When descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability.

**Claim 25.** See claim 1.

**Claim 26.** Maloney teaches said method and system, wherein the address is an e-mail address (page 6, line 32).

**Claim 27.** Said method and system, wherein the information about how to purchase the beauty product includes a hyperlink to a location from which the beauty product may be ordered (page 16, lines 26-34).

**Claim 29.** Storing an identification code of the subject (page 17, lines 12-13).

**Claim 30.** Maloney teaches said method and system, wherein the guidance is further based of at least one of a demographic location of the subject and an environmental condition at a demographic location of the subject (page 17, line 33).

**Claim 31.** See claim 1.

**Claim 32.** See claim 1.

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**Claim 33.** See claim 27.

**Claim 34-35.** See claim 1.

**Claim 43-45.** See claim 1.

**Claim 46.** Said method and system, wherein personal attribute information characterizes at least one of the subject's hair, skin, eyes, and facial features (page 7, line 1).

**Claim 47.** See claim 1.

**Claim 51-52.** See claim 1.

**Claim 60-62 and 64-66.** See claim 1.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 2-3, 7-8, 16, 28, 37-42, 54-55, 57-58, 63 and 68-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney in view of Shim (US 2003/0078854).**

### **Independent Claims.**

**Claim 55.** Maloney teaches said method and system, comprising: receiving profile information about the consumer, the profile information reflecting at least one of physical attribute information and lifestyle information about the consumer; recommending at least one beauty product to the consumer as a function of the received profile information (page 6, line 29 – page 7, line 15).

However, Maloney does not teach that said received information includes information reflective of an astrological horoscope sign of the subject; and that said

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recommending a beauty product step is conducted as a function of the consumer astrological horoscope sign.

Shim teaches a method and system for providing advertisement over the network, wherein consumers are classified in accordance with information including a zodiac sign, consumer's birthday and year the consumer was born [0174]; [0180]; [0194]. Said information and classification is utilized to offer the consumer beauty-related products [0052]; [0207].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include recommending a beauty product to the consumer as a function of the information including a zodiac sign, consumer's birthday, the year the consumer was born and consumer astrological horoscope sign, as disclosed in Shim, because it would advantageously attract attention to said advertising campaign, thereby increase the effectiveness of advertising and bring more revenue.

**Dependent Claims.**

**Claims 2-3, 7-8, 16 and 54. See claim 55.**

**Claim 28.** Shim teaches said method and system, wherein the address is an address of a mobile receiver/transmitter of the subject [0026].

**Claims 37-38. See claim 55.**

**Claim 39. See claim 26.**

**Claims 40-42. See claim 55.**

**Claims 57-58. See claim 55.**

**Claims 63 and 68-69. See claim 55.**

**Dependent claims 21-23 and 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney in view of Shim, further in view of Nordbye (US 3,936,957) and further in view of Williams (US 3,968,661).**

**Claims 21-23 and 48-50.** Maloney teaches all the limitations of claims 21-23 and 48-50, including receiving from the consumer personal beauty information including

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birth related information; and recommending a beauty product based on said information (page 7, lines 1-2); except specifically teaching making a suggestion that a course of future events may change based on use of at least one specified beauty product.

Shim teaches said method and system for providing advertisement of beauty-related products over the network, wherein consumers are classified in accordance with personal information including a western zodiac sign fortune, consumer's birthday and year the consumer was born [0194]. Said information and classification is utilized to determine the social type of the consumer [0174]; [0180]; and offer the consumer beauty-related products [0052]; [0207]. Determining the social type of the consumer obviously indicates predicting (suggesting) future behavior of the consumers. However, Shim does not explicitly teach that said zodiac signs of fortune are associated with changing a course of future events.

Nordbye teaches that throughout history it has been customary for people to wear various adornments for superstitious purposes. For example, jewelry with zodiac signs were worn to bring good luck (C. 1, L. 5-9, 30), thereby obviously indicating that the course of future events may be changed based on use of a certain jewelry incorporating said zodiac signs of fortune. However, Nordbye does not explicitly teach that jewelry relates to cosmetic purposes.

Williams teaches an article of jewelry for personal wear comprising zodiac signs provided thereon; wherein said article has a cosmetic significance (C. 2, L. 5, 30; C. 3, L. 22).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said personal, birth related information includes zodiac signs of fortune, as disclosed in Shim, because recommending a beauty product as a function of said zodiac signs of fortune would advantageously stimulate consumers to buy more beauty products. And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney and Shim to include that the use of said beauty product, recommended based on consumer's zodiac sign of fortune, could result in a predicted

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future occurrence, as disclosed in Nordbye and Williams, because it would advantageously stimulate the consumers to buy said beauty product, thereby increase revenue.

### ***Response to Arguments***

Applicant's arguments filed 8/30/2004 have been fully considered but they are not persuasive.

In response to applicant's argument that Maloney fails to disclose *providing guidance for the subject, the guidance at least including beauty advice and being a function of at least some of the profile information and birth-related classification*, the examiner points out that Maloney explicitly teaches said features. Specifically, Maloney teaches: classifying a consumer based on the criteria including at least one of personal attribute information and lifestyle information (page 6, line 29 – page 7, line 15); advising the subject of the at least one predefined categories into which the subject is classified; and dispensing guidance including beauty advice, the guidance being a function of an lifestyle and age stage information of the consumer and the at least one predefined category into which the subject is classified (page 7, lines 30-31).

In response to applicant's argument that Maloney fails to disclose *providing guidance for the subject, the guidance at least including beauty advice and being a function of the subject's astrological horoscope sign and at least some of the received profile information*, it is noted that Maloney teaches: providing guidance including beauty advice, the guidance being a function of an lifestyle and age stage information of the consumer and the at least one predefined category into which the subject is classified (page 7, lines 30-31). As per *astrological horoscope sign*, Shim was applied for this feature.

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In response to applicant's argument that Shim fails to disclose *providing guidance for the subject, the guidance at least including beauty advice and being a function of the subject's astrological horoscope sign and at least some of the received profile information*, the examiner stipulates that Maloney teaches: providing guidance including beauty advice, the guidance being a function of an lifestyle and age stage information of the consumer and the at least one predefined category into which the subject is classified (page 7, lines 30-31). Shim was applied to show providing advertisement related to beauty-related products [0052]; [0207] over the network based on consumer classification in accordance with a consumer's zodiac sign, consumer's birthday and year the consumer was born [0174]; [0180]; [0194].

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Maloney and Shim relate to displaying beauty-related information to consumers based on consumer information. The motivation to combine Maloney and Shim to include recommending to the consumer said beauty product as a function of a zodiac sign, consumer's birthday, the year the consumer was born and consumer astrological horoscope sign, because it would advantageously enhance the effectiveness of advertising of said beauty-related products, thereby potentially increase revenue.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:

**(703) 872-9306** [Official communications; including After Final  
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.



JOHN G. WEISS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

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11/20/2004